

## II. REMARKS

Respectfully, and generally for the reasons set forth below, the objections and rejections, and each ground therefore, are traversed.

In paragraphs 1-5 appear to be moot in that the earlier rejection was based on Van Name, which was distinguished (paragraphs 1-5). Applicant appreciates consideration of the IDS and LeRoy and Mondulli, and agrees that they do not disclose the claimed invention. With regard to paragraph 7, Bezos 2002/0178089 is not prior art, but it has a claim of priority preceding Applicant's filing date.

In paragraph 8 of the Office Action, the Examiner has rejected claims 1-4, 10-12, 19, 29 and 33 pursuant to 35 U.S.C. Sec. 102. The Examiner contends that these claims anticipated by Bezos.

In response, the rejection is respectfully traversed. There is no disclosure of receiving a request to send a blind gift or processing said request to send said blind gift, enabling said blind gift to be sent.... Indeed, there is no mention of the desirability of a blind gift. The locations in Bezos cited in the Office Action are silent as to these claim requirements, as per the feature mentioned in the prior claims of while said non-pseudonymous name is not revealed.... An absent teaching in Bezos is not a teaching that something is absent. Thus, Bezos cannot be said to teach or disclose these positively recited requirements. Indeed, nothing in Besoz appears to contemplate anything other than a conventional gift and is structured for the different purpose of "delivery of a gift whose order specifies insufficient delivery information." See page 1, Col. 2, lines 15-16. The cited art shows no recognition of the problem solved by the claimed invention, and no solution to the unrecognized problem has been shown either. Therefore, the evidence is not sufficient for proving statutory anticipation.

Claims 5, 6, 7, and 8 have been rejected pursuant to 35 U.S.C. Sec. 103. The Examiner contends that the requirements of these claims are obvious over Besoz in view of

Baron.

In response, the contentions and rejection are respectfully traversed. The undisclosed features mentioned above with respect to the Sec. 102 rejection are equally applicable here in that the evidence does not teach or disclose them, and thus the evidence is insufficient to establish *prima facie* statutory obviousness either. *In re Fine*. More particularly, an unobvious starting material of a claimed process will establish patentability. *In re Ochini; In re Brower*. In the instant claims, there is no teaching of the starting request to send said blind gift. Indeed, there is no comprehension in the cited art of the desirability of, need for, or anything about requesting a blind gift, so it cannot be obvious to inventing a means to effectuate a blind gift. Because the cited art does not teach the problem solved by the invention, nor the starting material (request), the evidence is insufficient to establish *prima facie* statutory obviousness. See, also, *In re Soonable; Eibel Process v. Minnesota & Ontario Paper*.

Claim 5 has been rejected based on Besoz, Barron, and Official Notice. With regard to the combination, including taking of Official Notice in claim 5 (and the rejection of other claims that depend from it (6-8)), if the rejection is maintained, a reference is required. In the examiner's comments responsive to this demand from the prior, the Examiner declined to provide such a reference when it was required. However, MPEP Sec. 2144.03 also provides "If the applicant traverses such an assertion the Examiner should cite a reference in support of his or her position." In declining to cite a reference (page 3 of the present Office Action), the Examiner contends that "no argument as to the invalidity of the Official Notice is present in the remarks. However, there is no requirement for a contention of invalidity in MPEP Sec. 2144.03. See also 37 C.F.R. Sec. 1.104. The rejection is improper, the refusal to provide a reference is improper, and if the rejection is maintained, a reference is required.

Additionally, this is an improper use of Official Notice because it is the principle evidence to reject the giving step in the claim. Pursuant to MPEP Sec. 2144.03, the facts so

noticed... should not comprise... principle evidence upon which a rejection is based.). In re Eynde, 480 F.2d 1364, 1370, 178 USPQ 470, 474 (CCPA 1973) ("The facts constituting the state of the art are normally subject to the possibility of rational disagreement among reasonable men and are not amenable to the taking of [judicial] notice.")

Additionally, Applicant is not aware of a prior art law that "consumers be given an opportunity to 'opt out' of marketing programs for the benefit of personal privacy," as the Examiner contends. Proof is required.

Further, the requirements of claim 5 do not appear to have anything to do with opting out of a marketing program of the sort that might be the subject of a prior art law. Thus, even if such a reference were to be produced, a proper reason to combine must be shown, and the Examiner apparently would still fail to make out a case of *prima facie* statutory obviousness.

(A reference is required to allow determination of whether a proper reason to combine has been provided.)

The same is true regarding the rejection based on "known systems." A reference is required as per the foregoing regarding the purported law. Applicant has no idea what the Examiner is referring to, and thus cannot respond particularly nor determine whether a proper reason to combine does or does not exist.

The foregoing regarding Official Notice and rejection of claim 8 is also true, e.g., the use of the Official Notice is improper, the notice seems to be beside the point of the claim requirements, and while a reference is required, such a reference would not be sufficient to make out a case of *prima facie* statutory obviousness. The foregoing requirement is equally true about rejecting claim 7 in part based on "known systems." If the rejection is maintained, a reference is required for each and every use of Official Notice and what is otherwise "known."

By statute, the PTO bears the burden of proving *prima facie* obviousness. This burden is not met by allegations of what the Examiner believes is "known systems" and is the

basis for the Official Notice (challenged hereby with the respective requirements for supporting references).

And if the rejection is not withdrawn at least in view of the points raised regarding the Sec. 102 rejection (i.e., the cited art does not have any suggestion of a blind gift), all rejections based on Sec. 103 (including those discussed below) contain two errors. First, the reason to combine has not been shown in the prior art. In the Office Action, the Examiner loosely paraphrases Applicant's prior argument by contending at page 2, paragraph 3, that "applicant's assertion that the problem to be solved, or motivation must be in the reference is incorrect." However, *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1984) held: "The prior art must provide one of ordinary skill in the art the motivation to make the proposed... modifications needed to arrive at the claimed [invention].") If the Examiner wishes to attempt to persuade the Federal Circuit to overturn *In re Lalu*, he will also have to deal with such consistent decisions as, *In re Lee*; *In re Rouffet*; and *In re Kotzab*, which require the same.

In the instant rejection, the Examiner has not shown that the motivation to combine the cited art and/or Official Notice was in the prior art, in contrast, for example, with being a subsequent hindsight inspired by Applicant's claims. For the invention to be obvious at the time of the invention, the motivation must have been evident at that time, and evidence of that motivation at that time is required.

Further, the Sec. 103 rejection as applied to all claims is erroneous for failing to consider the invention as a whole, as is required by that statute. The invention as a whole is directed toward enabling a blind gift, a concept that is not mentioned in the cited prior art. The invention may not be rejected by dissecting the claim elements into parts contended to be shown in cited art (though in different contexts), but instead the claim must be considered as a whole. E.g., *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1548, 220 USPQ 303,

309 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984); Jones v. Hardy, 727 F.2d 1524, 1530, 220 USPQ 1021, 1026 (Fed. Cir. 1983). The rejection pertaining to obviousness does not consider the invention as a whole, as is required by 35 U.S.C. Sec. 103.

In sum, it is believed that the absence of any mention of a blind gift in the cited art is sufficient to distinguish over the cited art, especially in view of the other requirements to effectuate one. Nonetheless, the other matters raised herein are preserved if necessary for appeal.

Claims 13-14, 16-118, and 20 have been rejected pursuant to 35 U.S.C. Sec. 103. The Examiner contends that the requirements of these claims are obvious over Besoz in view of Hudson.

In response, the contention and rejection is respectfully traversed. There is nothing in the cited art that mentions a blind gift, so assembling references to effectuate one cannot be anything but a hindsight reconstruction inspired by Applicant's claims. Hudson may disclose charging a fee, but not a fee for the blind gift, and reading Hudson, one would have no idea of a fee suitable for the undisclosed concept of effectuating a blind gift. As per the words of the Examiner, it is the wrong "transaction." And Hudson could not be combined with Besoz without contradicting the respective teachings particularly in that Hudson pertains to banking cards intended for "off-line" use (see, e.g., Summary of the Invention), while Besos is a on line system—this in addition to the Sec. 103 errors discussed above.

In sum, it is believed that the absence of any mention of a blind gift in the cited art is sufficient to distinguish over the cited art, especially in view of the other requirements to effectuate one. Nonetheless, the other matters raised herein are preserved if necessary for appeal.

Claims 11, and 26-28 have been rejected pursuant to 35 U.S.C. Sec. 103. The Examiner contends that the requirements of these claims are obvious over Besoz in view of

Wolfe.

In response, the contention and rejection is respectfully traversed. There is nothing in the cited art that mentions a blind gift, so assembling references to effectuate one cannot be anything but a hindsight reconstruction inspired by Applicant's claims.

And while Wolf discloses a means for communication, it is not disclosed in the combination preceded by blind gift processing. These are disparate teachings (greeting card and on line gift delivery system for incomplete addresses) that have not been shown properly combinable or sufficient to suggest the invention as a whole.

In sum, it is believed that the absence of any mention of a blind gift in the cited art is sufficient to distinguish over the cited art, especially in view of the other requirements to effectuate one. Nonetheless, the other matters raised herein are preserved if necessary for appeal.

### III. Conclusion

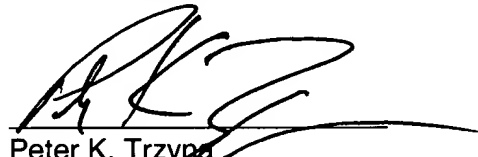
The Examiner has graciously provided numerous ways to communicate regarding the instant case, and the Applicant and undersigned are most appreciative. The Examiner is invited to contact the undersigned at the telephone number set out below if it can in any way expedite or facilitate issuance of a patent on the application.

The application is believed to be in condition for allowance, and favorable action is respectfully requested. Please direct all correspondence to the undersigned at the address given below.

Respectfully submitted,

Date:

May 16, 2003



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